

## Request for Reconsideration after Final Action

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SERIAL NUMBER	76649149
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
ARGUMENT(S)	
<p>The Applicant respectfully requests reconsideration of the final refusal of its applied for mark "PATSY'S PIZZERIA," and respectfully submits that there would be, and is no, likelihood of confusion between its applied-for mark and the mark in U.S. Registration No. 3,090,551.</p> <p>Registration No. 3,090,551 is for the mark "PATSY'S OF NEW YORK" for restaurant services in International Class 43. The Applicant's mark is "PATSY'S PIZZERIA" for pizzeria services in International Class 43.</p> <p>In deciding if there is a likelihood of confusion, thirteen various factors should be considered, if applicable. <i>In re E.I. Du Pont de Nemours &amp; Co.</i>, 476 F.2d, 1357 1361 (Fed. Cir. 1973). Among these factors are the similarity or dissimilarity of the impressions of the marks, including appearance, sound, and connotation; the similarity or dissimilarity and nature of the services; the conditions under which, and to whom, sales are made; the variety of goods on which a mark is used; the length of time and conditions of concurrent use without actual confusion; and any other established fact probative of the effect of use. <i>Id.</i></p> <p>Doubts about the likelihood of confusion should then be resolved <b>against the newcomer, and in favor of the prior user</b> or registrant. <i>In re Chatam Int'l Inc.</i>, 380 F.3d 1340, 1345, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004); and <i>W.R. Grace &amp; Co. v. Herbert J. Meyer Industries, Inc.</i>, 190 U.S.P.Q. 308 (T.T.A.B. 1976). In the instant case the Applicant has been using its mark "PATSY'S PIZZERIA" for pizzeria services since 1933. The Registrant of Registration No. 3,090,551 began its use subsequently on October 2005, for restaurant services only. Since Registration No. 3,090,551 is the newcomer, by decades, any doubts regarding the likelihood of confusion should be resolved in favor of the Applicant.</p> <p><b>1. Dissimilarity of the Marks' Impressions</b></p> <p>Restaurant services and pizzeria services are typically provided through a physical location, with associated marks displayed at least on signage outside the restaurant or pizzeria or on menus, which are also typically posted outside the restaurant. Even in instances where a restaurant or pizzeria offers takeout service, the menus showing the marks associated with the restaurant are seen first. Presumably, the Registrant's restaurant services are primarily sold in this same visual or self-service manner. Therefore, both the Applicant's and the Registrant's marks are first, and primarily, encountered visually.</p> <p>For goods typically purchased in a visual or self-service manner, where the purchaser sees the goods being bought, sound is not as important. <i>See Spanger Candy Co. v. Crystal Pure Candy Co.</i>, 235 F. Supp. 18, 22, 143 U.S.P.Q. 94, 98 (N.D. Ill. 1964). Phonetic similarities become important when the</p>	

good is typically sold in a manner relying on sound, such as over the telephone or by radio. *See Lindy Pen Co., Inc. v. Bic Pen Corp.*, 796 F.2d 254, 256, 230 U.S.P.Q. 791, 793 (9th Cir. 1986). Since the Applicant's and Registrant's services are sold on a self-service basis, the visual impact predominates over any phonetic impact. *See Roux Laboratories, Inc. v. Clairol, Inc.*, 157 U.S.P.Q. 391 (T.T.A.B. 1968).

The visual impression of the Applicant's mark is distinct from that of the Registrant's mark. The Applicant's mark PATSY'S PIZZERIA is comprised of two elements. The Registrant's mark PATSY'S OF NEW YORK is comprised of four elements. The only shared element is PATSY'S.

The inclusion of the element PIZZERIA in the Applicant's mark explains to the public that the services offered by the Applicant are related to pizzerias – a very distinct type of food service that differs from restaurant services in general. *See infra*. In contrast, the Registrant's mark is completely devoid of any suggestion that the Registrant offers pizzeria services. Rather, the Registrant's mark includes OF NEW YORK. This is a geographical indicator that is completely lacking from the Applicant's mark. Since both marks are encountered visually, and not phonetically, this visual difference alone creates a different commercial impression between the Applicant's and the Registrant's respective mark. The source identifying elements of the Registrant's mark, OF NEW YORK, is completely lacking from the Applicant's mark. Similarly, the source identifying elements of the Applicant's mark, PIZZERIA, is completely lacking from the Registrant's mark. The differences between the elements and details of the marks lead to distinct visual impressions.

To the extent the Examining Attorney asserts that the element PATSY'S is the dominant portion of each mark, the issue of whether the Applicant and the Registrant can both use marks including PATSY'S has been resolved by the Eastern District of New York, and affirmed by the Second Circuit. “[T]he right to register follows the right to use ‘as nearly as possible.’” *In re Multivox Corporation of America*, 1981 TTAB LEXIS 41, \*17 (T.T.A.B. Feb. 20, 1981) (citing *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973)). The Court's holdings should be followed under the principle of stare decisis, which is applicable to ex parte examinations for trademark applications. *See In re Multivox Corporation* and *In re Bordo Products Company*, 1975 TTAB LEXIS 125 (T.T.A.B. Sept. 25, 1975).

[The d]octrine of stare decisis rests upon principle that law by which men are governed should be fixed, definite and known, and that, when the law is so declared by court of competent jurisdiction authorized to construe it, such declaration, in absence of palpable mistake or error, is itself evidence of the law until changed by competent authority.

*In re Multivox*, 1981 TTAB LEXIS 41, at \*11 (quoting Black's Law Dictionary (Third Edition 1933)). “[The doctrine of stare decisis, [] is based upon adherence to precedents, is necessary to provide uniform guidelines and principles to be followed by lawyers as well as by those in a judicial capacity in the interpretation and application of the law based thereon.” *In re Bordo*, 1975 TTAB LEXIS 125, at \*7-8.

Any initial impression that the doctrine has little applicability in proceedings involving trademarks in view of the well-known statement that each case has its own personality and must be decided on its own particular facts . . . must necessarily be tempered by the desire and need to end multiple litigation on the same issues or fact situations not only for the purpose of judicial economy but also to protect a party, who was successful in one protracted and expensive proceeding, from having to relitigate the same issue again and again.

*In re Multivox*, 1981 TTAB LEXIS 41, at \*12-13 (citing *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151 (C.C.P.A. 1978)).

The Eastern District of New York determined, and the Second Circuit affirmed, after protracted and expensive proceedings, that the Applicant was entitled to use the mark PATSY'S PIZZERIA for pizzeria services and the Registrant was entitled to use the mark PATSY'S ITALIAN RESTAURANT

for restaurant services. *See* Exhibit 1, Opinion and Order of the Eastern District of New York, holding the Applicant “has established the right to use the mark[] . . . PATSY’S PIZZERIA for pizzeria services” (p. 67); and “the parties [must] define their marks distinctly as PATSY’S ITALIAN RESTAURANT and PATSY’S PIZZERIA; to define the distinct sets of services that they provide; Neopolitan-style fine Italian dining and coal-oven-style pizzeria and related services” (p. 70). *See also* Exhibit 2, Opinion and Order of Second Circuit, holding “The original Patsy’s Pizzeria opened in 1933” (p. 6), noting that the jury found the Applicant “was the senior user of the mark[] PATSY’S PIZZERIA and continuously used the mark[] for pizzeria services but not restaurant services” (p. 12); and upholding the distinction between “pizzeria service” and “restaurant services” (pp. 30-31). This holding was based in part on the Applicant’s prior use, and that of its predecessors, of PATSY’S PIZZERIA. (Exhibit 1, p. 15.) The Eastern District also held that “[s]tarting in the 1990s, [the Applicant] began entering into licensing agreement that allowed other to open establishments bearing the mark PATSY’S PIZZERIA.” (Exhibit 1, p. 6.) The Courts’ holdings, finding that the Applicant has trademark rights to PATSY’S PIZZERIA, despite the use of PATSY’S ITALIAN RESTAURANT by the Registrant, is applicable under the doctrine of stare decisis to this application.

The Applicant’s mark in the Court proceedings and in the instant application are identical. Moreover, the services in this application are the same services at issue in the prior proceedings. Therefore, the Courts’ findings on the Applicant’s rights to the mark PATSY’S PIZZERIA clearly fall within the realm of stare decisis. While the Registrant’s mark in the Court proceedings varies from the Registrant’s mark cited against the Applicant, the similarities between the Registrant’s two marks are not sufficient to prevent the application of stare decisis, particularly if the Examining Attorney views “PATSY’S” as the dominant feature of the marks. The Registrant’s mark in the prior proceeding included only a description of the type of services, and therefore if the Applicant’s addition of PIZZERIA to PATSY’S is not sufficient to distinguish the Applicant’s Mark, the addition of ITALIAN RESTAURANT to PATSY’S would not be sufficient to distinguish the Registrant’s mark in the prior proceedings from the Registrant’s mark cited against the Applicant here. More importantly, if the Examining Attorney views PATSY’S as the dominant portion of the Applicant’s and Registrant’s marks at issue in this application, then the same dominant feature was at issue and decided upon in the prior proceeding.

Therefore, to the extent that PATSY’S is the dominant feature of the Applicant’s and the Registrant’s marks, the Applicant’s right to use the mark PATSY’S PIZZERIA has already been determined by the Courts, despite the Registrant’s contemporaneous use of marks including the term PATSY’S. Since the Courts have previously decided that the Applicant has the right to use PATSY’S PIZZERIA services, and since “the right to register follows the right to use ‘as nearly as possible,’” the Applicant also has a right to register the instant application. *In re Multibox*, 1981 TTAB LEXIS 41, at \*17 (citing *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563).

Additional factors that favor applying stare decisis and allowing the Applicant’s mark to proceed to publication include: (1) the services the Applicant now seeks to register with the mark PATSY’S PIZZERIA are the services considered by the Courts; (2) the claimed date of first use for the Registrant’s Registration No. 3,090,551 is subsequent to the date established by the Applicant in the prior proceeding; and (3) the prior proceedings were based on findings of fact and law regarding the likelihood of confusion – and not merely a “‘feeling’ that confusion was likely.” *Compare with In re Multivox*, 1981 TTAB LEXIS 41, at \*14-15.

Finally, the equitable concerns that persuaded the Board to allow the previously-refused application to issue in *In re Multivox*, are applicable here. In *In re Multivox*, the Board noted: [C]onsidering that applicant would otherwise be precluded from ever seeking to renew its attempt at registration . . . because it cannot seek to cancel the cited registrations because they have been in existence for over five years . . . and because applicant cannot seek an adjudication by way of a declaratory judgment since [the registrant] has not

recently made any overtures to applicant or its customers which could justify such a proceeding, *it would be inequitable not to publish* the [applied for] mark. . . .

1981 TTAB LEXIS 41, at \*19 (emphasis added). Similarly, here, the cited registration has been in existence for five years and the Registrant has not made any overtures to the Applicant or its customer to justify a declaratory judgment. It would be inequitable not to publish the Applicant's mark.

## **2. The Dissimilarities of the Services**

The Applicant's services (pizzeria services) and the Registrant's services (restaurant services) are also dissimilar. As an initial matter, no customer seeking the Registrant's restaurant services would encounter the Applicant's pizzeria services and believe the two services are the same.

The Applicant's services are for pizzeria services – not restaurant services. This distinction between pizzeria service and restaurant services is important and has been recognized by the federal courts. The Court specifically found in the prior proceeding a distinction between restaurant services and pizzeria services. (Exhibit 1, pp. 24-25.) The Court's holding distinguishing the services is entitled to stare decisis. *See supra*. Moreover, extrinsic evidence may be considered to show that the description has a specific meaning. *See, e.g., In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1638 & n.10 (T.T.A.B. 2009), and *In re Trackmobile Inc.*, 15 U.S.P.Q.2d 1152, 1154 (T.T.A.B. 1990). In addition to the Court's holding distinguishing pizzeria and restaurant services, a principal of the Registrant has testified that the Registrant had not franchised its restaurant services and it was a family-operated business. (*See* Exhibit 3, p. 76, lines 5-15.)

Considering the distinction between pizzeria services and restaurant services, the multiple differences in the Applicant's services and the Registrant's services further diminish any likelihood of confusion.

## **3. The Applicant's Mark Is Used on a Variety of Goods**

The Applicant has used the name PATSY'S PIZZERIA in conjunction with pizzeria services since 1933. The prior use of PATSY'S PIZZERIA by the Applicant and its predecessors has been recognized by the Courts. (*See* Exhibit 1, p. 15.) The Applicant has been using its mark "PATSY'S PIZZERIA" for franchising services since December 31, 1998. (*See* Exhibit 4, U.S. Trademark Serial No. 77/086,491 and specimen.) The Applicant's repeated use of the trademark PATSY'S PIZZERIA not only pizzeria service but also franchising services creates a general pattern associating the mark PATSY'S PIZZERIA with the Applicant. *See Motorola, Inc. v. Griffiths Electronics, Inc.*, 317 F.2d 397, 137 U.S.P.Q. 551 (C.C.P.A. 1963).

## **4. Concurrent Use without Actual Confusion**

The Applicant first used the mark PATSY'S PIZZERIA for pizzeria services in commerce since 1933. The Registrant claims its first use of the mark PATSY'S OF NEW YORK for restaurant services in commerce was October 2005. In the eight years since, the two marks have been used concurrently without any evidence of actual confusion between the Registrant's restaurant services and the Applicant's pizzeria services known to the Applicant. A significant length of time of contemporaneous use without any evidence of actual confusion is strong evidence that there will be no confusion in the future. *In re American Management Assos.*, 218 U.S.P.Q. 477, 478 (T.T.A.B. 1983).

The dissimilarity of the commercial impressions of the Applicant's mark and the Registrant's mark, dissimilarity of the services, and lack of actual confusion all weigh against a likelihood of confusion between the Applicant's mark and Registration No. 3,090,551.

The Applicant respectfully requests that the application be allowed and the mark passed to publication.

## **EVIDENCE SECTION**

### **EVIDENCE FILE NAME(S)**

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<b>ORIGINAL PDF FILE</b>	<a href="#">evi_20948230132-232030460_.01US.Exhibit_4.04162013.pdf</a>
<b>CONVERTED PDF FILE(S) (10 pages)</b>	<a href="\\TICRS\EXPORT16\IMAGEOUT16\766\491\76649149\xml7\RFR0131.JPG">\\TICRS\EXPORT16\IMAGEOUT16\766\491\76649149\xml7\RFR0131.JPG</a>
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<b>DESCRIPTION OF EVIDENCE FILE</b>	Exhibit 1, Opinion and Order of the Eastern District of New York; Exhibit 2, Opinion and Order of Second Circuit; Exhibit 3, Deposition; and Exhibit 4,

	U.S. Trademark Serial No. 77/086,491 and specimen.
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Brandi G. Brenner/
<b>SIGNATORY'S NAME</b>	Brandi G. Brenner
<b>SIGNATORY'S POSITION</b>	Attorney for Applicant
<b>SIGNATORY'S PHONE NUMBER</b>	202-429-4560
<b>DATE SIGNED</b>	04/16/2013
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Tue Apr 16 23:43:35 EDT 2013
<b>TEAS STAMP</b>	USPTO/RFR-209.48.230.132- 20130416234335936187-7664 9149-5007f45e6616ee6b350e b37817fc383de7c9e805cc028 c424c7988bcce8482f4ad-N/A -N/A-20130416232030460665

## Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **76649149** has been amended as follows:

### ARGUMENT(S)

**In response to the substantive refusal(s), please note the following:**

The Applicant respectfully requests reconsideration of the final refusal of its applied for mark “PATSY’S PIZZERIA,” and respectfully submits that there would be, and is no, likelihood of confusion between its applied-for mark and the mark in U.S. Registration No. 3,090,551.

Registration No. 3,090,551 is for the mark “PATSY’S OF NEW YORK” for restaurant services in International Class 43. The Applicant’s mark is “PATSY’S PIZZERIA” for pizzeria services in International Class 43.

In deciding if there is a likelihood of confusion, thirteen various factors should be considered, if

applicable. *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d, 1357 1361 (Fed. Cir. 1973). Among these factors are the similarity or dissimilarity of the impressions of the marks, including appearance, sound, and connotation; the similarity or dissimilarity and nature of the services; the conditions under which, and to whom, sales are made; the variety of goods on which a mark is used; the length of time and conditions of concurrent use without actual confusion; and any other established fact probative of the effect of use. *Id.*

Doubts about the likelihood of confusion should then be resolved **against the newcomer, and in favor of the prior user** or registrant. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1345, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004); and *W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 U.S.P.Q. 308 (T.T.A.B. 1976). In the instant case the Applicant has been using its mark "PATSY'S PIZZERIA" for pizzeria services since 1933. The Registrant of Registration No. 3,090,551 began its use subsequently on October 2005, for restaurant services only. Since Registration No. 3,090,551 is the newcomer, by decades, any doubts regarding the likelihood of confusion should be resolved in favor of the Applicant.

#### **1. Dissimilarity of the Marks' Impressions**

Restaurant services and pizzeria services are typically provided through a physical location, with associated marks displayed at least on signage outside the restaurant or pizzeria or on menus, which are also typically posted outside the restaurant. Even in instances where a restaurant or pizzeria offers takeout service, the menus showing the marks associated with the restaurant are seen first. Presumably, the Registrant's restaurant services are primarily sold in this same visual or self-service manner. Therefore, both the Applicant's and the Registrant's marks are first, and primarily, encountered visually.

For goods typically purchased in a visual or self-service manner, where the purchaser sees the goods being bought, sound is not as important. *See Spanger Candy Co. v. Crystal Pure Candy Co.*, 235 F. Supp. 18, 22, 143 U.S.P.Q. 94, 98 (N.D. Ill. 1964). Phonetic similarities become important when the good is typically sold in a manner relying on sound, such as over the telephone or by radio. *See Lindy Pen Co., Inc. v. Bic Pen Corp.*, 796 F.2d 254, 256, 230 U.S.P.Q. 791, 793 (9th Cir. 1986). Since the Applicant's and Registrant's services are sold on a self-service basis, the visual impact predominates over any phonetic impact. *See Roux Laboratories, Inc. v. Clairol, Inc.*, 157 U.S.P.Q. 391 (T.T.A.B. 1968).

The visual impression of the Applicant's mark is distinct from that of the Registrant's mark. The Applicant's mark PATSY'S PIZZERIA is comprised of two elements. The Registrant's mark PATSY'S OF NEW YORK is comprised of four elements. The only shared element is PATSY'S.

The inclusion of the element PIZZERIA in the Applicant's mark explains to the public that the services offered by the Applicant are related to pizzerias – a very distinct type of food service that differs from restaurant services in general. *See infra*. In contrast, the Registrant's mark is completely devoid of any suggestion that the Registrant offers pizzeria services. Rather, the Registrant's mark includes OF NEW YORK. This is a geographical indicator that is completely lacking from the Applicant's mark. Since both marks are encountered visually, and not phonetically, this visual difference alone creates a different commercial impression between the Applicant's and the Registrant's respective mark. The source identifying elements of the Registrant's mark, OF NEW YORK, is completely lacking from the Applicant's mark. Similarly, the source identifying elements of the Applicant's mark, PIZZERIA, is completely lacking from the Registrant's mark. The differences between the elements and details of the marks lead to distinct visual impressions.

To the extent the Examining Attorney asserts that the element PATSY'S is the dominant portion of each mark, the issue of whether the Applicant and the Registrant can both use marks including PATSY'S has been resolved by the Eastern District of New York, and affirmed by the Second Circuit. "[T]he right to register follows the right to use 'as nearly as possible.'" *In re Multivox Corporation of America*, 1981 TTAB LEXIS 41, \*17 (T.T.A.B. Feb. 20, 1981) (citing *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973)). The Court's holdings should be followed under the principle of stare decisis, which is applicable to ex parte examinations for trademark applications. *See In re Multivox Corporation and In re Bordo Products Company*, 1975 TTAB LEXIS 125 (T.T.A.B. Sept. 25, 1975).

[The d]octrine of stare decisis rests upon principle that law by which men are governed should be fixed, definite and known, and that, when the law is so declared by

court of competent jurisdiction authorized to construe it, such declaration, in absence of palpable mistake or error, is itself evidence of the law until changed by competent authority.

*In re Multivox*, 1981 TTAB LEXIS 41, at \*11 (quoting Black's Law Dictionary (Third Edition 1933)). "[The doctrine of stare decisis, [] is based upon adherence to precedents, is necessary to provide uniform guidelines and principles to be followed by lawyers as well as by those in a judicial capacity in the interpretation and application of the law based thereon." *In re Bordo*, 1975 TTAB LEXIS 125, at \*7-8.

Any initial impression that the doctrine has little applicability in proceedings involving trademarks in view of the well-known statement that each case has its own personality and must be decided on its own particular facts . . . must necessarily be tempered by the desire and need to end multiple litigation on the same issues or fact situations not only for the purpose of judicial economy but also to protect a party, who was successful in one protracted and expensive proceeding, from having to relitigate the same issue again and again.

*In re Multivox*, 1981 TTAB LEXIS 41, at \*12-13 (citing *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151 (C.C.P.A. 1978)).

The Eastern District of New York determined, and the Second Circuit affirmed, after protracted and expensive proceedings, that the Applicant was entitled to use the mark PATSY'S PIZZERIA for pizzeria services and the Registrant was entitled to use the mark PATSY'S ITALIAN RESTAURANT for restaurant services. *See* Exhibit 1, Opinion and Order of the Eastern District of New York, holding the Applicant "has established the right to use the mark[] . . . PATSY'S PIZZERIA for pizzeria services" (p. 67); and "the parties [must] define their marks distinctly as PATSY'S ITALIAN RESTAURANT and PATSY'S PIZZERIA; to define the distinct sets of services that they provide; Neopolitan-style fine Italian dining and coal-oven-style pizzeria and related services" (p. 70). *See also* Exhibit 2, Opinion and Order of Second Circuit, holding "The original Patsy's Pizzeria opened in 1933" (p. 6), noting that the jury found the Applicant "was the senior user of the mark[] PATSY'S PIZZERIA and continuously used the mark[] for pizzeria services but not restaurant services" (p. 12); and upholding the distinction between "pizzeria service" and "restaurant services" (pp. 30-31). This holding was based in part on the Applicant's prior use, and that of its predecessors, of PATSY'S PIZZERIA. (Exhibit 1, p. 15.) The Eastern District also held that "[s]tarting in the 1990s, [the Applicant] began entering into licensing agreement that allowed other to open establishments bearing the mark PATSY'S PIZZERIA." (Exhibit 1, p. 6.) The Courts' holdings, finding that the Applicant has trademark rights to PATSY'S PIZZERIA, despite the use of PATSY'S ITALIAN RESTAURANT by the Registrant, is applicable under the doctrine of stare decisis to this application.

The Applicant's mark in the Court proceedings and in the instant application are identical. Moreover, the services in this application are the same services at issue in the prior proceedings. Therefore, the Courts' findings on the Applicant's rights to the mark PATSY'S PIZZERIA clearly fall within the realm of stare decisis. While the Registrant's mark in the Court proceedings varies from the Registrant's mark cited against the Applicant, the similarities between the Registrant's two marks are not sufficient to prevent the application of stare decisis, particularly if the Examining Attorney views "PATSY'S" as the dominant feature of the marks. The Registrant's mark in the prior proceeding included only a description of the type of services, and therefore if the Applicant's addition of PIZZERIA to PATSY'S is not sufficient to distinguish the Applicant's Mark, the addition of ITALIAN RESTAURANT to PATSY'S would not be sufficient to distinguish the Registrant's mark in the prior proceedings from the Registrant's mark cited against the Applicant here. More importantly, if the Examining Attorney views PATSY'S as the dominant portion of the Applicant's and Registrant's marks at issue in this application, then the same dominant feature was at issue and decided upon in the prior proceeding.

Therefore, to the extent that PATSY'S is the dominant feature of the Applicant's and the

Registrant's marks, the Applicant's right to use the mark PATSY'S PIZZERIA has already been determined by the Courts, despite the Registrant's contemporaneous use of marks including the term PATSY'S. Since the Courts have previously decided that the Applicant has the right to use PATSY'S PIZZERIA services, and since "the right to register follows the right to use 'as nearly as possible,'" the Applicant also has a right to register the instant application. *In re Multibox*, 1981 TTAB LEXIS 41, at \*17 (citing *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563).

Additional factors that favor applying stare decisis and allowing the Applicant's mark to proceed to publication include: (1) the services the Applicant now seeks to register with the mark PATSY'S PIZZERIA are the services considered by the Courts; (2) the claimed date of first use for the Registrant's Registration No. 3,090,551 is subsequent to the date established by the Applicant in the prior proceeding; and (3) the prior proceedings were based on findings of fact and law regarding the likelihood of confusion – and not merely a "feeling" that confusion was likely." *Compare with In re Multivox*, 1981 TTAB LEXIS 41, at \*14-15.

Finally, the equitable concerns that persuaded the Board to allow the previously-refused application to issue in *In re Multivox*, are applicable here. In *In re Multivox*, the Board noted: [C]onsidering that applicant would otherwise be precluded from ever seeking to renew its attempt at registration . . . because it cannot seek to cancel the cited registrations because they have been in existence for over five years . . . and because applicant cannot seek an adjudication by way of a declaratory judgment since [the registrant] has not recently made any overtures to applicant or its customers which could justify such a proceeding, *it would be inequitable not to publish* the [applied for] mark. . . .

1981 TTAB LEXIS 41, at \*19 (emphasis added). Similarly, here, the cited registration has been in existence for five years and the Registrant has not made any overtures to the Applicant or its customer to justify a declaratory judgment. It would be inequitable not to publish the Applicant's mark.

## **2. The Dissimilarities of the Services**

The Applicant's services (pizzeria services) and the Registrant's services (restaurant services) are also dissimilar. As an initial matter, no customer seeking the Registrant's restaurant services would encounter the Applicant's pizzeria services and believe the two services are the same. The Applicant's services are for pizzeria services – not restaurant services. This distinction between pizzeria service and restaurant services is important and has been recognized by the federal courts. The Court specifically found in the prior proceeding a distinction between restaurant services and pizzeria services. (Exhibit 1, pp. 24-25.) The Court's holding distinguishing the services is entitled to stare decisis. *See supra*. Moreover, extrinsic evidence may be considered to show that the description has a specific meaning. *See, e.g., In re Thor Tech, Inc.*, 90 U.S.P.Q.2d 1634, 1638 & n.10 (T.T.A.B. 2009), and *In re Trackmobile Inc.*, 15 U.S.P.Q.2d 1152, 1154 (T.T.A.B. 1990). In addition to the Court's holding distinguishing pizzeria and restaurant services, a principal of the Registrant has testified that the Registrant had not franchised its restaurant services and it was a family-operated business. (*See* Exhibit 3, p. 76, lines 5-15.)

Considering the distinction between pizzeria services and restaurant services, the multiple differences in the Applicant's services and the Registrant's services further diminish any likelihood of confusion.

## **3. The Applicant's Mark Is Used on a Variety of Goods**

The Applicant has used the name PATSY'S PIZZERIA in conjunction with pizzeria services since 1933. The prior use of PATSY'S PIZZERIA by the Applicant and its predecessors has been recognized by the Courts. (*See* Exhibit 1, p. 15.) The Applicant has been using its mark "PATSY'S PIZZERIA" for franchising services since December 31, 1998. (*See* Exhibit 4, U.S. Trademark Serial No. 77/086,491 and specimen.) The Applicant's repeated use of the trademark PATSY'S PIZZERIA not only pizzeria service but also franchising services creates a general pattern associating the mark PATSY'S PIZZERIA with the Applicant. *See Motorola, Inc. v. Griffiths Electronics, Inc.*, 317 F.2d 397, 137 U.S.P.Q. 551 (C.C.P.A. 1963).



#### **4. Concurrent Use without Actual Confusion**

The Applicant first used the mark PATSY'S PIZZERIA for pizzeria services in commerce since 1933. The Registrant claims its first use of the mark PATSY'S OF NEW YORK for restaurant services in commerce was October 2005. In the eight years since, the two marks have been used concurrently without any evidence of actual confusion between the Registrant's restaurant services and the Applicant's pizzeria services known to the Applicant. A significant length of time of contemporaneous use without any evidence of actual confusion is strong evidence that there will be no confusion in the future. *In re American Management Assos.*, 218 U.S.P.Q. 477, 478 (T.T.A.B. 1983).

The dissimilarity of the commercial impressions of the Applicant's mark and the Registrant's mark, dissimilarity of the services, and lack of actual confusion all weigh against a likelihood of confusion between the Applicant's mark and Registration No. 3,090,551.

The Applicant respectfully requests that the application be allowed and the mark passed to publication.

#### **EVIDENCE**

Evidence in the nature of Exhibit 1, Opinion and Order of the Eastern District of New York; Exhibit 2, Opinion and Order of Second Circuit; Exhibit 3, Deposition; and Exhibit 4, U.S. Trademark Serial No. 77/086,491 and specimen. has been attached.

#### **Original PDF file:**

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#### **Converted PDF file(s) (73 pages)**

[Evidence-1](#)

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**Original PDF file:**

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**Original PDF file:**

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[Evidence-1](#)

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[Evidence-9](#)

[Evidence-10](#)

**SIGNATURE(S)**

**Request for Reconsideration Signature**

Signature: /Brandi G. Brenner/ Date: 04/16/2013

Signatory's Name: Brandi G. Brenner

Signatory's Position: Attorney for Applicant

Signatory's Phone Number: 202-429-4560

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 76649149

Internet Transmission Date: Tue Apr 16 23:43:35 EDT 2013

TEAS Stamp: USPTO/RFR-209.48.230.132-201304162343359

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# ***EXHIBIT 1***

**UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF NEW YORK**

-----X

PATSY'S ITALIAN RESTAURANT, INC.,  
PATSY'S BRAND, INC.,

Plaintiffs,

**OPINION & ORDER**

- against -

06-CV-0729 (RER)

ANTHONY BANAS d/b/a PATSY'S,  
PATSY'S PIZZERIA,

Defendants.

-----X

-----X

PATSY'S ITALIAN RESTAURANT, INC.,

Plaintiff and  
Counterclaim Defendant,

- against -

06-CV-5857 (RER)

ANTHONY BANAS d/b/a PATSY'S and  
PATSY'S PIZZERIA TRATTORIA IMPAZZIRE,  
ALLAN ZYLLER d/b/a PATSY'S and PATSY'S  
PIZZERIA TRATTORIA IMPAZZIRE, AL &  
ANTHONY'S PATSY'S, INC., I.O.B. REALTY,  
INC., and PATSY'S, INC.,

Defendants and  
Counterclaim Plaintiffs.

-----X

**RAMON E. REYES, JR., U.S.M.J.:**

More than five years ago, the Court of Appeals for the Second Circuit admonished the major parties in this litigation "that henceforth they would be well advised to minimize the risk of confusion by identifying their restaurants by the complete names: 'Patsy's Italian Restaurant' and 'Patsy's Pizzeria.'" *Patsy's Brand, Inc. v. I.O.B. Realty, Inc.*, 317 F.3d 209, 221 (2d Cir. 2003). This lengthy Opinion and Order is written because the parties have largely ignored that

admonition. During the intervening years, the parties have instead continued on an oftentimes labyrinthine course of litigation. As noted by the Court of Appeals, one source of this litigation's "unavoidable confusion" has been the fact that, for over sixty years, the major parties and their predecessors have shared the mark PATSY'S for nearly identical restaurant-related services, both within the same New York City market. See *Patsy's Brand, Inc.*, 317 F.3d at 217. Additional confusion occurred during proceedings before the Patent and Trademark Office (the "PTO") and the Trademark Trial and Appeal Board (the "TTAB"). These proceedings have been alternately described as "protracted and convoluted," *Patsy's Italian Rest., Inc. v. Banas*, 508 F. Supp. 2d 194, 203 (E.D.N.Y. 2007), and "a procedural morass," "tortured" and "resulting in confusion and mistake." *I.O.B. Realty, Inc. v. Patsy's Brand, Inc.*, TTAB Cancellation Nos. 92028142 & 92029614, at 10, 15 (June 28, 2007) (unpublished decision submitted as Defs.' Ex. III, herein "TTAB Decision"). Such was the muddled state of affairs that formed the starting point for this case.

As this case made its way toward a jury trial, its "convoluted" and "tortured" procedural history presented considerable practical challenges in resolving the thorny legal and factual issues raised by the parties' simultaneous and long-standing use of the mark PATSY'S. In coping with these challenges, the Court was reminded that trademark law's fundamental purpose is to not only "encourage investments in strong trademarks, but also 'to protect the ability of consumers to distinguish among competing producers.'" *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 539 (2d Cir. 2005) (quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985)) (emphasis added). As described in greater detail below, the jury's findings in this case make clear that consumers are having grave difficulties distinguishing

between the parties' marks. It is with this in mind, and for the foregoing reasons, that the Court makes the following rulings on the parties' post-verdict motions for injunctive relief: (1) the PTO is ordered to cancel Plaintiffs' registration number 3,009,836 for the stylized mark PATSY'S PR for restaurant services; (2) the PTO is ordered to cancel Plaintiffs' registration number 3,009,866 for the unstylized mark PATSY'S for restaurant services not including pizza; (3) the PTO is ordered not to restore I.O.B. Realty, Inc.'s registration number 2,213,574 for the mark PATSY'S PIZZERIA for restaurant services; (4) Plaintiffs are enjoined from using the mark PATSY'S alone in any advertising, signs, menus or anything similarly associated with their restaurant services; and (5) Defendants are enjoined from using the mark PATSY'S alone in any advertising, signs, menus or anything similarly associated with their pizzeria services. Additional injunctive relief is granted to Plaintiffs as described below. *See infra* Section III.D. The parties remaining motions are denied.

### **BACKGROUND**

I assume familiarity with the facts of this case, including the procedural history and facts described in previous decisions in this case and in the "Sauce Litigation."<sup>1</sup> I do acknowledge that a full understanding of this Opinion and Order requires extensive prior knowledge of this case. It is simply an impossible and unwieldy task to include a complete set of facts and procedural

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<sup>1</sup> The "Sauce Litigation" was an action brought by Patsy's Brand, Inc. in the District Court for the Southern District of New York involving trademark infringement of pasta sauce labels. Moving from oldest to most recent, a time line of the pertinent decisions is as follows: *Patsy's Brand, Inc. v. I.O.B. Realty, Inc.*, No. 99-CV-10175(JSM), 2001 WL 170672, 58 U.S.P.Q.2d 1048 (S.D.N.Y. Feb. 21, 2001) (granting summary judgment for Patsy's Brand, Inc.); *Patsy's Brand, Inc. v. I.O.B. Realty, Inc.*, No. 99-CV-10175(JSM), 2001 WL 1154669 (S.D.N.Y. Oct. 1, 2001) (entering judgment, including attorneys' fees and costs, for Patsy's Brand, Inc.); *Patsy's Brand, Inc. v. I.O.B. Realty, Inc.*, 317 F.3d 209 (2d Cir. 2003) (affirming judgment upon modifications of injunctive relief).

history in a single document. The blame for this unfortunate situation lies with the convoluted and protracted manner in which the parties allowed this litigation to progress.

Instead, I will describe only so much of the background as is necessary to understand my rulings. Further, the reader is directed to the previous decisions in this case. Moving from oldest to most recent, a time line of the pertinent decisions in this action is as follows: *Patsy's Italian Rest., Inc. v. Banas*, 2006 WL 3478988 (E.D.N.Y. Nov. 30, 2006) (Docket Entry 32)<sup>2</sup> (Irizarry, J.) (affirming my order that this action be consolidated); *Patsy's Italian Rest., Inc. v. Banas*, 2007 WL 174131 (E.D.N.Y. Jan. 19, 2007) (Docket Entry 67) (Irizarry, J.) (granting in part plaintiffs' motion to quash subpoena of plaintiffs' counsel); *Patsy's Italian Rest., Inc. v. Banas*, 508 F. Supp. 2d 194 (E.D.N.Y. 2007) (Docket Entry 110) (Irizarry, J.) (granting in part defendants' motion to correct the PTO register and denying defendants' remaining motions for summary judgment); *Patsy's Italian Rest., Inc. v. Banas*, 2007 WL 3232232 (E.D.N.Y. Oct. 31, 2007) (Docket Entry 117) (Irizarry, J.) (denying plaintiffs' motion for reconsideration of the Court's order to correct the PTO register); *Patsy's Italian Rest., Inc. v. Banas*, 531 F. Supp. 2d 483 (E.D.N.Y. 2008) (Docket Entry 124) (Reyes, J.) (granting defendants' motion in limine to exclude expert's proffered testimony); *Patsy's Italian Rest., Inc. v. Banas*, 2008 WL 495568 (E.D.N.Y. Feb. 20, 2008) (Docket Entry 130) (Reyes, J.) (denying plaintiffs' motion to amend action number 06-CV-5957 to add Patsy's Brand, Inc. as a plaintiff); *Patsy's Italian Rest., Inc. v. Banas*, 2008 WL 795341 (E.D.N.Y. Mar. 24, 2008) (Docket Entry 175) (Reyes, J.) (rulings on the parties' motions in limine); *Patsy's Italian Rest., Inc. v. Banas*, 2008 WL 850151 (E.D.N.Y.

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<sup>2</sup> Except where otherwise noted, all references to docket entries in this opinion correspond with case number 06-CV-5857. For the most part, identical papers were filed in case number 06-CV-0729.



